

### **REMARKS**

Claims 1-28 are pending in the application. Of these pending claims, Claims 2, 3, 16, 17, 27, and 28 stand rejected under 35 U.S.C. §112, second paragraph; Claims 1-4, 6, 8, 10, 12-18, 21 and 24-28 stand rejected under 35 U.S.C. §102(b) as being anticipated by Meuli, et al. (U.S. Patent No. 5,092,896); Claims 5, 7, 19, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Meuli, et al. in view of Bramlet (U.S. Patent No. 5,986,970); and Claims 9, 11, 22, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Meuli, et al, in view of Saffar (U.S. Patent No. 5,047,059).

By this amendment, Claims 2, 3, 16, 17, 27, and 28 have been amended and new Claims 29 and 30 have been added. The basis for these amendments can be found throughout the specification, claims and drawings as originally filed. No new matter has been added.

The preceding amendments and the following remarks are believed to be fully responsive to the outstanding Office Action and are believed to place the application in condition for allowance. In view of the preceding amendments and the following remarks, the rejections are traversed and reconsideration of this application is respectfully requested.

### **REJECTION UNDER 35 U.S.C. §112**

Claims 2, 3, 16, 17, 27, and 28 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicants regard as the invention. By this amendment, the

above-identified claims have been amended in a non-narrowing manner to particularly point out and distinctly claim the subject matter, which Applicants regard as the invention so as to overcome the rejection under 35 U.S.C. §112, second paragraph. Accordingly, withdrawal of this rejection is respectfully requested.

**REJECTIONS UNDER 35 U.S.C. § 102(b) and §103(a)**

Claims 1-4, 6, 8, 10, 12-18, 21 and 24-28 stand rejected under 35 U.S.C. §102(b) as being anticipated by Meuli, et al. (U.S. Patent No. 5,092,896); Claims 5, 7, 19, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Meuli, et al. in view of Bramlet (U.S. Patent No. 5,986,970); and Claims 9, 11, 22, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Meuli, et al, in view of Saffar (U.S. Patent No. 5,047,059). Applicants respectfully traverse these rejections.

In this regard, Meuli, et al. is directed to a finger joint prosthesis having pegs 3 and 4, which are separated by an intermediate layer 6. Pegs 3 and 4 consist of sintered hydroxylapatite. The intermediate layer 6 consists of polyurethane or other biocompatible plastic, which is capable of sliding and which impedes the build-up of bone. Positioned outside the joint is an elastic hose or stocking 8 formed of a resorbable material.

In contradistinction, independent Claims 1, 15, and 26 clearly set forth a substantially elongated member comprised of a resorbable material to be used for insertion into a first phalange and a second phalange so as to join the first and second phalanges. Meuli, et al. clearly identifies that the pegs 3 and 4 are formed of sintered hydroxylapatite and the intermediate layer is formed of polyurethane or other

biocompatible plastic, which is capable of sliding and which impedes the build-up of bone. This structure clearly teaches away from Applicants' claimed device, which identifies that the device is formed of a resorbable material, which permits bone ingrowth. In fact, Meuli, et al. clearly teaches away from forming the device from a resorbable material since it identifies that the implant "impedes the build up of bone" (see column 2, line 20). Meuli, et al. merely sets out that an elastic hose or stocking 8 formed of a resorbable material may be used for wrapping the finger joint. Accordingly, Meuli, et al. does not anticipate nor render obvious Applicants' independent Claims 1, 15, and 26, along with their corresponding dependent claims.

Bramlet is directed to an arthroplasty joint assembly and is preferably formed from a silicone-based polymer, known as silastic. The member further includes screws or fasteners formed from titanium, titanium based alloy, stainless steel or cobalt chromium alloy. Saffar is directed to a prosthesis for metacarpophalangeal or interphalangeal articulation of the fingers. This device is formed from polyethylene and metallic rods. As such, Bramlet or Saffar, or the combination of Bramlet and Saffar with Meuli, et al. also do not teach or suggest Applicants' independent Claims 1, 15, or 26, along with their corresponding dependent claims. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. §103 be withdrawn.

### **NEW CLAIMS**

New Claims 29 and 30 are directed to a device for insertion into a first phalange and a second phalange so as to fuse the first phalange and the second phalange. It is clearly set out in independent Claim 29 and 30, that the device is formed of a

substantially rigid elongated material having a middle portion with a fixed curve to form a fixed angle between a first end portion and a second end portion.


In contradistinction, Meuli, et al., Bramlet and Saffar clearly identify joints having a movable or flexible middle portion, thereby specifically teaching away from Applicants' independent Claims 29 and 30. Accordingly, independent Claims 29 and 30 are also allowable over the prior art of record.

### CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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## **ATTACHMENT FOR CLAIM AMENDMENTS**

The following is a marked up version of each amended claim in which underlines indicates insertions and brackets indicate deletions.

2. (Amended) The invention according to Claim 1, wherein the first end portion is operable to be implanted into a phalange [is] selected from [the] a group consisting of proximal phalanges, intermediate phalanges, distal phalanges, and combinations thereof.

3. (Amended) The invention according to Claim 1, wherein the second end portion is operable to be implanted into a phalange [is] selected from [the] a group consisting of proximal phalanges, intermediate phalanges, distal phalanges, and combinations thereof.

16. (Amended) The invention according to Claim 15, wherein the first end portion is operable to be implanted into a phalange [is] selected from [the] a group consisting of proximal phalanges, intermediate phalanges, distal phalanges, and combinations thereof.

17. (Amended) The invention according to Claim 15, wherein the second end portion is operable to be implanted into a phalange [is] selected from [the] a group

consisting of proximal phalanges, intermediate phalanges, distal phalanges, and combinations thereof.

27. (Amended) The invention according to Claim 26, wherein providing a bore includes providing a bore in the first phalange [is] selected from [the] a group consisting of proximal phalanges, intermediate phalanges, distal phalanges, and combinations thereof.

28. (Amended) The invention according to Claim 26, wherein providing a bore includes providing a bore in the second phalange [is] selected from [the] a group consisting of proximal phalanges, intermediate phalanges, distal phalanges, and combinations thereof.